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| 09/843,771 | 04/30/2001 | Gideon Fostick | Q63730 | 1088 |
| 7590 01/21/2004 SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 PENNSYLVANIA AVENUE, N.W. WASHINGTON, DC 20037-3213 | | | EXAMINER CHOW, MING | |
| | | | ART UNIT 2645 | PAPER NUMBER 7 |
| DATE MAILED: 01/21/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,771

Applicant(s)

FOSTICK, GIDEON

Examiner

Ming Chow

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9 and 11-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the Interactive Voice Response System claimed in claims 6, 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 24 is objected to because of the following informalities: "iii. An Automatic Voice Recognition" should be read as "An Automatic Voice Recognition". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al (US: 6483899), and in view of Skinner et al (US: 6529737).

Regarding claim 1, Agraharam et al teach on column 1 line 52-60 a voice-messaging system (claimed "CAS") converts voice message into a text message (claimed "non-voice format") by using the speech recognition software (claimed "AVRS").

Agraharam et al failed to teach "replying to the converted voice messages by a voice message reply". However, Skinner et al teach on column 2 line 62 to column 3 line 5-7 subscriber responds (claimed "reply") to the received message (SMS that is converted from the voice message) by placing a separate phone call. Agraharam et al teach on column 2 line 19-32 a network-based voice messaging system that takes an voice message, converts the voice message to a text message, and then sends the converted message to the intended recipient. When the original message recipient responds with a voice message, the original message recipient is a sender of the responding message. This voice responding message, as taught by Agraharam et al, is sent to the network-based voice messaging system, converted to a text message, and is sent to the intended recipient (the sender of the original message).

Therefore, in combination of Agraharam et al and Skinner et al, it is a perfect motivation to modify Agraharam et al in view of Skinner et al so that the system of Agraharam et al can support sending and responding with a voice message, converting the voice message to a text message, delivering the converted voice message to the intended recipient.

Regarding claims 2 and 3, Agraharam et al teach on column 1 line 60-64 the text message is transmitted to the recipient as an electronic mail or a facsimile document. It is inherent there must be interfaces to e-mail and FAX, and the receiving communication devices must be e-mail and FAX enabled.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Agraharam et al as applied to claim 1 above, and in view of Skinner et al, Fortman (US: 6203192). Agraharam et al in view of Skinner et al failed to teach "CAS is.....SMS message". However, Fortman teaches on column 6 line 67 to column 7 line 3 translating voice messages (item 1220 Fig. 1 POTS telephone) to SMS messages. It would have been obvious to one skilled at the time the invention was made to modify Agraharam et al, Skinner et al to have the "CAS is.....SMS message" as taught by Fortman such that the modified system of Agraharam et al, Skinner et al would be able to support the SMS to the system users.

5. Claims 6-9, 11-15, 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al, and in view of Nakatsu et al (US: 5787151).

Art Unit: 2645

Skinner et al teach on column 2 line 47 to column 3 line 7 the originator sends a voice message that is converted by a voice recognition system into an SMS. Skinner et al teach on item 20 Fig. 1 “telecommunications switch” (claimed “CAS”).

Skinner et al failed to teach “an Interactive.....pre-prepared messages”. However, Nakatsu et al teach on item 84 Fig. 3 IVR and column 2 line 10-50 a user selects from various pre-prepared greetings (claimed message”) and also records his name, recipient’s name, a personal introduction, and a personal good-bye to form a new personalized voice message. By Skinner’s system, the new personalized voice message can be converted to be an SMS (claimed “CAS provides a text message”) which includes the claimed “the pre-prepared message and said text”.

It would have been obvious to one skilled at the time the invention was made to modify Skinner et al to have the “an Interactive.....pre-prepared messages” as taught by Nakatsu et al such that the modified system of Skinner et al would be able to support the IVR, pre-prepared messages to the system users.

6. Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al, and in view of Nakatsu et al (US: 5787151).

Skinner et al in view of Nakatsu et al failed to teach “the plurality.....called party”. The pre-prepared message as taught by Nakatsu et al must be pre-programmed by a party. Therefore, “Official Notice” is taken that it is old and well known to one skilled in the art that any party can be a called party for having received telephone messages.

Art Unit: 2645

It would have been obvious to one skilled at the time the invention was made to modify Skinner et al, Nakatsu et al to have the “the plurality.....called party” such that the modified system of Skinner et al, Nakatsu et al would be able to support the called party to pre-program the messages to the system users.

Response to Arguments

7. Applicant's arguments filed on 10/2/03 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 15, regarding claim 1. Applicant's argument is not persuasive. Detail rejection has been stated above relative to the amended claim 1.
- ii) Applicant argues, on pages 16-17, regarding claims 6-15. Rejections have been stated above relative to the amended limitations.

Conclusion

Art Unit: 2645

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

Application/Control Number: 09/843,771

Page 8

Art Unit: 2645

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to TC2600's Customer Service FAX Number 703-872-9314.

Patent Examiner

Art Unit 2645

Ming Chow

(m)

Allan Hoosain
ALLAN HOOSAIN
PRIMARY EXAMINER for
Fan Tsang